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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/073,548 | 02/11/2002 | Sukhdev Swami Handa | 07064-012001 / 0820-NF236 | 5091 |

26161 7590 08/24/2005

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| EXAMINER | |
|---|---|
| MELLER, MICHAEL V | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1655 | |

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/073,548 | HANDA ET AL. | |
| | Examiner | Art Unit | |
| | Michael V. Meller | 1655 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *27 June 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-64* is/are pending in the application.

4a) Of the above claim(s) *25-58* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24, 59-64* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

## DETAILED ACTION

### *Election/Restrictions*

Claims 25-58 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions. Election was made **without** traverse in the reply filed on 6/1/2004.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-24, 59-64 are rejected under 35 U.S.C. 102(b) as being anticipated by Grollier et al. (col. 4, lines 40-45, examples), Nguyen (col. 3, lines 9-20, and lines 35-47) or WO 99/11223 (abstract, examples).

The references each teach that Indigofera tinctoria is known to be used in compositions, namely cosmetic types. Bioactive trans-tetracos-15-enoic acid is inherently in the plants since that is where the acid is extracted from.

The claimed dosages refer to a treatment which is not applicable to the claimed subject matter since the claims being examined are to a composition. In other words, the dosage is limiting the intended use which carries no patentable weight in the claims since the claim is to a composition and not the method of using that composition.

The solvents used to extract the plant extract are not claim limitations since the same compounds will be extracted since the same plant as applicants are using are also used in the references.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-24, 59-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grollier et al. (col. 4, lines 40-45, examples), Nguyen (col. 3, lines 9-20, and lines

35-47) or WO 99/11223 (abstract, examples) taken with JP 401211519 (abstract) or JP 49019039 (abstract).

Grollier, Nguyen and WO each teach that Indigofera tinctoria is known to be used in compositions, namely cosmetic types (hair and skin). Bioactive trans-tetracos-15-enoic acid is inherently in the plants since that is where the acid is extracted from.

The claimed dosages refer to a treatment which is not applicable to the claimed subject matter since the claims being examined are to a composition. In other words, the dosage is limiting the intended use which carries no patentable weight in the claims since the claim is to a composition and not the method of using that composition.

The solvents used to extract the plant extract are not claim limitations since the same compounds will be extracted since the same plant as applicants are using are also used in the references.

The JPs teach that dehydrocholic acid is known to be used in skin and hair compositions as well.

Since the Indigofera tinctoria (bioactive trans-tetracos-15-enoic acid) and the dehydrocholic acid are known to be used for the same purpose individually in the art, namely for treating skin and hair, then it would have been obvious to use them together in a single formulation since they are known individually in the art to be used for the same purpose.

It is well known that it is *prima facie* obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third

composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. *In re Sussman,* 1943 C.D. 518; *In re Pinten*, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); *In re Susi*, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); *In re Crockett*, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960).

> The reason or motivation to modify a reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. While there must be motivation to make the claimed invention, there is no requirement that the prior art provide the same reason as the applicant to make the claimed invention.
>
> MPEP 2144 Sources of Rationale Supporting a Rejection Under 35 U.S.C. 103. <http://www.uspto.gov/web/offices/pac/mpep/documents/2100_2144.htm>

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael V. Meller whose telephone number is 571-272-0967. The examiner can normally be reached on Monday thru Thursday: 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on 571-272-0974. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael V. Meller
Primary Examiner
Art Unit 1655

MVM